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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,563	08/02/2000	Keiichi Nakajima	000790/0007	9970
26610 7590 10/04/2007 STROOCK & STROOCK & LAVAN LLP 180 MAIDEN LANE NEW YORK, NY 10038			EXAMINER POND, ROBERT M	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/630,563

**Applicant(s)**

NAKAJIMA, KEIICHI

**Examiner**

Robert M. Pond

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4,36-51 and 63-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4,36-51 and 63-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/15/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to After Final Amendment***

All pending claims 2, 4, 36-51 and 63-74 were examined in this non-final office action necessitated by new grounds of rejection. Claims 1, 3, 5-35 and 52-62 were canceled in previous office action.

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 16 August 2007, with respect to the rejection(s) of claim(s) 2, 4, 36-51 and 63-74 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wilf. Toohey was withdrawn as a primary reference. Arguments based on Toohey are rendered moot. Official Notice was withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**1. Claims 36-41, 43-48, 50, 51, 63-68, 70 and 74 are rejected under 35 USC 102(e) as being anticipated by Wilf (US 5,899,980).**

Wilf teaches all the limitations of claims 36-41, 43-48, 51, 63-68 and 74. For example, Wilf discloses an electronic settlement system for setting up a transaction through a communication network (see at least abstract; Fig. 1; col. 1-col. 7). Wilf further discloses:

- a paying terminal which is operated for participating in the transaction, said paying terminal being connectable to the communication network and including an information indicating unit, said paying terminal including an input unit for inputting information regarding the transaction; customer terminal transfers point-of-sale computer ID and transaction details to a secure transaction server (see at least Fig. 4 (110); col. 7, lines 46-57).
- a virtual register which is connectable to the communication network for participating in the transaction with said paying terminal; Inherent in Wilf are the structures necessary to permit generating the virtual register. For example, the ISP server providing billing functions for the customer transaction is managing and storing the customer data. The ISP computer is connectable to the communication network for participating in the transaction and manages the billing of a customer in accordance with the purchase of goods from various merchants (see at least col. 6, lines 56-64). Also note: disclosed that a telephone company could provide billing functions as an alternative to the ISP.

- a synchronizing server communicating with said paying terminal secure transaction server communicates with customer terminal and with said virtual register, transaction server communicates with ISP server that provides billing functions said synchronizing server setting up link information including transaction ID information in association with said virtual register and transmits said link information to said paying terminal upon receipt by said synchronizing server of the information regarding the transaction transmitted by said paying terminal, secure transaction server sends the customer computer station a transaction verification form, HTML or Java, which informs the customer about the requested product or service, the price and payment terms for the transaction. The transaction verification form also included information which is not shown to the customer including the address of the ISP server which provides service to the customer. This information is obtained from the database or the table accessible to the secure transaction server by using the automatically revealed IP address of the customer computer station and said synchronizing server establishing a synchronization of communication between said paying terminal and said virtual register one-to-one upon receipt of both the same transaction ID information and a signal in response to the link information from said paying terminal. customer workstation and ISP interact one-to-one. ISP records the transaction details including the customer's name, current date and time,

the price of the product or service and payment terms. The ISP then connects to the secure transaction server and communicates customer response. See col. 7, line 46-col. 8, line 41.

- Regarding claim 37 and others, further comprising a cashier server connected to said synchronizing server via the communicating network, said cashier server generating said virtual register. Please note: the ISP server providing billing functions for the customer transaction which is serving the function of the Applicant's cashier server.
- Regarding claim 38 and others, wherein said paying terminal comprises at least one of a cellular phone, a PDA and a notebook type personal computer, customer workstation is a computer of which a notebook type personal computer would suffice, and said information regarding the transaction comprises paying terminal information including at least one of a telephone number and an e-mail address of said paying terminal. secure transaction server uses customer's email address to communicate messages (see at least col.10, lines 28-30; col. 12, lines 46-52). Please note: customer's email address is information regarding the transaction.
- Regarding claim 39 and others, further comprising:
  - a paying terminal database for storing paying terminal information including at least one of a telephone number and an e-mail address of the paying terminal; a previously noted, the customer's email address is stored and used to facilitate transactions.

- and a virtual register database for storing virtual register information including at least information for identifying said virtual register, which information being indicated on said indicating unit of said paying terminal; database stores table of ISP providing virtual register functions (see at least col. 7, line 62-col. 8, line 5).
- wherein said synchronizing server identifies said paying terminal based on the paying terminal information transmitted from said paying terminal and the paying terminal information stored in said paying terminal database and transmits the virtual register information as a part of the link information to said paying terminal. URL information of ISP providing billing services is transmitted to the customer terminal (see at least col. 7, line 62-col. 8, line 5).
- Regarding claim 40 and others, wherein said synchronizing server transmits the virtual register information with an internet address to said paying terminal. secure transaction server transmits the ISP's internet address (see at least col. 7, line 62-col. 8, line 5); Internet (see at least Fig. 1 (10)).
- Regarding claim 41 and others, wherein the virtual register information includes information relating to an item for the transaction. As previously noted above (see at least col. 8, lines 32-36).
- Regarding claim 50 and others, first communicating unit connected to the virtual register via a first communication network, and a second

communicating unit connected to the paying terminal via a second communicating network. Paying terminal communicates with secure transaction server via a second network (comprises ISP network plus network to secure transaction sever). ISP communicates with secure transaction server via a first network using only the network to the secure transaction server.

**2. Claims 42, 49, 69, 71 and 73 are rejected under 35 USC 103(a) as being unpatentable over Wilf (US 5,899,980) in view PRN (PTO-892, Item: U).**

Wilf teaches all the above as noted under the 102(e) rejection and further teaches i) Internet vendors advertising products and services to solicit orders from buyers, and ii) transaction detail including the point-of-sale computer station ID. Although Wilf does not mention wherein the information regarding the transaction includes a number listed in at least one of a mail order advertisement and a catalog distributed to a user in advance, PRN on the other hand teaches Discopro.com delivering discounts and promotions to its subscribers via cell phones and alphanumeric pagers. PRN teaches Discopro.com customers redeeming a discount or promotion by referencing a promotional code (provided by Discopro.com) while purchasing the item on line, via the phone or in person just as they would with a paper coupon (U: see at least pages 1-3). Therefore it would have been obvious to modify Wilf to receive a promotional code in advance of a purchase and redeeming online, via the phone or in person just as



they would with a paper coupon as taught by PRN because a person of ordinary skill has good reason to pursue known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 5,883,810 (Franklin et al.) 16 March 1999; teaches billing and payment network wherein the customer interacts with bank to transact a purchase.
- US 6,629,135 (Ross et al.) 30 September 2003; teaches a cashier server that integrates billing transactions for a plurality of POS terminal.
- US 6,970,852 (Sendo et al.) 29 November 2005 ; teaches IMC web site synchronizing transactions between buyers and sellers.
- US 5,925,073 (Naftzger) 13 July 1999; teaches use of promotional codes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond  
Primary Examiner  
September 30, 2007